

B2 11. (Twice Amended) A surgical retractor blade, said retractor blade comprising a body having a first end, a second end, a channel adapted to engage one side of an incision in a patient, a rail extending along at least a portion of said body, and a plurality of open slots for receiving a suture therein, wherein said open slots have an internal wall and a suture locking member having a fixed end and a free end, said free end engaging said internal wall so as to clamp a suture placed between said free ended and said internal wall, wherein said first end is adapted for attaching to a separate, complete drive mechanism.

REMARKS

No new matter is believed to be added by the claims. The amendments are clearly supported by the specification and drawings as originally filed. Accordingly, entry of the above amendment is respectfully requested. A marked-up version of the changes made to the specification and claims by the current Amendment is provided herewith. This attachment is captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE.**"

35 USC §112:

As amended, claim 11 and those dependent therefrom (claims 12, 13 and 23) are believed to comply with the second paragraph of 35 U.S.C. §112. Accordingly, withdrawal of the rejection is requested.

35 U.S.C. §102 and §103:

Claims 8, 10 and 11 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,348,036 to Looney, *et al.* (Looney). While Looney has a filing date of July 1, 1999, it claims benefit to Provisional Application No. 60/117,333 filed January 24, 1999. Applicants concede that the relevant §102(e) date of Looney is January 24, 1999 *as to subject matter originally presented in the provisional application*. However, no indication in the Office Action suggests that the rejection is based on subject matter known by the Examiner to be supported by that "critical reference date." See MPEP 2136.03. If the Examiner is to maintain the rejection, it is respectfully requested that the Examiner review the provisional application to determine if it adequately discloses that which the Examiner asserts Looney patent discloses.

To assist in this enquiry, Applicants have submitted a copy of the subject provisional application (Provisional Application No. 60/117,333) in the Information Disclosure Statement provided herewith.

Regarding the subject matter actually disclosed therein, Applicants note that the '333 provisional does not include FIG. 3B referenced by the Examiner in rejecting claims 8, 10 and 11. From Applicants' review of the '333 application, there is no curved rail employed in the retractor blades shown. So much is particularly evident in view of figures 3 and 4 of the '333 application. The '333 application also fails to disclose a channel as might be relevant to the claims. Still further the slots (123) noted by the Examiner in the Looney patent are absent in the relevant provisional application. Finally, the clamp (124) referenced by the Examiner in the patent is not found in the '333 application.

Applicants remind the Examiner that in rejecting a claim under 35 USC §102, it is incumbent on an Examiner to provide such information as needed for the applicant to judge the propriety of continuing prosecution. *See* 35 USC §132. As such, if the rejection is to be maintained in view of the subject matter of the provisional application despite Applicants' observations, a reasoned explanation addressing Applicants' points is respectfully requested and required.

Regarding the rejection of claims 8-11 under §102(e) as anticipated by Hancock, Applicants have amended claims 8 and 11 such that they are believed to define over the reference. The structural "adaptation" required of the blade as now defined provides a member distinguishable from the always-attached blades of Hancock in which one includes drive assembly parts. With regard to the effect of the "adapted for" claim language, please see MPEP §2173.05(g) regarding its limiting effect.

Claims 21-23 were rejected under 35 U.S.C. §103 over Looney or Hancock in view of U.S. Patent No. 4,747,395 to Brief. However, Brief merely discloses the use of a polymer coating over a suitable metal blade body. Accordingly, it does not teach the "body" of a retractor blade be made of polymer as required by claims 21-23. Hence, Applicants assert that the proposed combination fails to meet the limitations of claims 21-23 since the reference does not supply what the Examiner regards as missing from Looney or Hancock.

In addition, Applicants refute that there is such similarity between the "blades" in Brief and those of Looney or Hancock to support a proper rejection. Indeed, Brief explicitly states that the intended purpose of the device described therein is for, "use in displacing muscle and other non-skeletal tissue." In marked contrast, the retractors disclosed in Looney and Hancock are suited for much higher force situations – namely, sternal (skeletal tissue) retraction. Thus, the combination of references (whether they disclose what is purported or not) is believed to be improper. In view of such differences, one

would not be motivated or reasonably expect success in the substitution because of the vastly different forcing/strength requirements contemplated by each application.

For either reason presented above, withdrawal of the rejection as to claims 21-23 is requested.

Allowable Subject Matter:

In view of the amendment to claim 11 above, it is believed that claims 12 and 13 are allowable as well in view of the Examiner's comments.

Further, Applicant are appreciative of the Examiner's indication that claims 1-6, 14-20, 24 and 25 are allowable.

IN CLOSING

In view of the above, the application is believed to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issue.

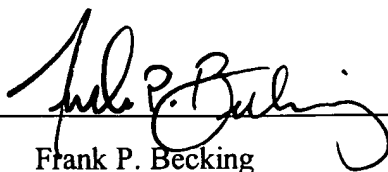
If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (650) 833-7778.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815. However, the Commissioner is not authorized to charge the issue fee.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

8. (Amended) A surgical retractor blade [for attaching to a drive mechanism], said retractor blade comprising a polymeric body having a first end, a second end, a channel adapted to engage one side of an incision in a patient, and a rail extending along at least a portion of said polymeric body, wherein said first end is adapted for attaching to a separate, complete drive mechanism.

11. (Twice Amended) A surgical retractor blade [for attaching to a drive mechanism], said retractor blade comprising a body having a first end, a second end, a channel adapted to engage one side of an incision in a patient, a rail extending along at least a portion of said body, and a plurality of open slots for receiving a suture therein, wherein said open slots have an internal wall and a suture locking member having a fixed end and a free end, said free end engaging said internal wall so as to [claim] clamp a suture placed between said free ended and said internal wall, wherein said first end is adapted for attaching to a separate, complete drive mechanism.